

Appl. No. 09/965,757  
Amdt. Dated 01/27/2006  
Reply to the Office Action of October 27, 2005

### REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed October 27, 2005. In the Office Action, claims 1-17 were rejected under 35 U.S.C. § 103(a). Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### *Rejection Under 35 U.S.C. § 103*

Claims 1-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lowry, a publication entitled "Object Code Optimization," in view of Chang, a publication entitled "Using Profile Information to Assist Classic Code Optimizations" and Mills (U.S. Patent No. 6,205,544) Applicant respectfully traverses the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988)*. Herein, Applicant respectfully submits that the combined teachings of the cited references fail to describe or suggest all the claim limitations.

Moreover, Applicant respectfully traverses the rejection because Mills does not constitute a prior art reference under 35 U.S.C. §103(a) because 35 U.S.C. § 103(c) excludes references which may qualify as prior art under 35 USC § 102(e), (f), and (g) from being used as a prior art reference under 35 U.S.C. §103(a). The text of 35 U.S.C. §103(c) recites that "[s]ubject matter developed by another person, which qualifies as prior art under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." *See 35 U.S.C. §103(c), MPEP 706.02(I)(1)*.

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Herein, Mills is a U.S. patent assigned to Intel Corporation and recorded in 1999 by the USPTO (Reel 010046/Frame 0214). The subject application was filed on September 28, 2001 and also assigned to Intel Corporation (Reel 012215/Frame 0349). Hence, the subject matter (Mills) and the claimed invention were, at the time the invention was made, owned by Intel Corporation or subject to an obligation of assignment to Intel Corporation.

Therefore, Applicant respectfully requests that the Examiner withdraw this outstanding §103(a) rejection as applied to claims 1-17.

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**Conclusion**

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: January 27, 2006

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Susan McFarlane

01/27/2006

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